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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/662,278

09/14/2000

William Duvall

9230

7590

03/31/2003

Rines & Rines  
81 North State Street  
Concord, NH 03301

EXAMINER

APPIAH, CHARLES NANA

ART UNIT

PAPER NUMBER

2682

DATE MAILED: 03/31/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

24



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**Commissioner of Patents and Trademarks**

See attached

# Office Action Summary

Application No.

09/662,278

Applicant(s)

DUVALL ET AL.

Examiner

Charles Appiah

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed on 8 November 2000 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Applicants' have failed to submit the I.D.S. on a PTO Form 449. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Specification***

2. The title of the invention is not descriptive and too long. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Method and System for portable cellular phone voice communication and positional location data communication".

### ***Claim Objections***

3. Claims 5 and 6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of

Art Unit: 2682

“vehicle fleet dispatchers or managers access the GPS-transponder modules of the vehicles of the fleet tracking the location of such vehicles without interrupting the vehicle driver or user” have no prior antecedent basis to the parent claim.

***Claim Rejections - 35 USC § 112***

4. Claims 1, 5, 8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 8, the recitation of “the GPS satellite constellation” and “the vehicle” lack clear antecedent basis in the claims.

With respect to claims 5 and 14, “the GPS-transponder modules of the vehicles” lack prior antecedent basis in the claim.

***Double Patenting***

5. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 14 of copending Application No. 09/235,606. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. Claims 1 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7 and 17 of copending Application No. 09/235,606. Although the conflicting claims are not identical, they are not patentably distinct from each other because for example the limitation of “sending a radio signal from the control center over the data channel path” and “to

activate the transponder to transmit the processed location data over the data channel path" recited in the instant invention is substantially not different from the claimed limitation of "sending a radio signal from the control center over the control channel path" and "to activate the transponder to transmit the processed location data over the channel path" recited in the application, and as such it would have been obvious to one of ordinary skill in the art to substitute a control channel path for the data channel path in the instant invention in order to send radio signals different from voice signals.

Furthermore the claimed limitation of a control channel path of the application is broad enough to encompass the limitation of a data channel path of the instant invention

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pace, II (5,712,899)** in view of **Girerd et al. (6,131,067)**.

Regarding claims 1 and 8, Pace discloses a method and system for voice and positional location data radio communication over a cellular phone network having a cellular voice channel path communicating with a network operations control center (exchange of information signals between base communications unit operator and

Art Unit: 2682

person calling for information, see Fig. 9) and a data radio channel path separately (feature of provision of visual images to the mobile operator while simultaneously communicating with the base operator, col. 6, lines 30-39), the method comprising user voice calling the control center from a portable cellular telephone location over the cellular voice path, requesting location and other information services (see col. 3, lines 4-28), sending a radio signal from the control center over the data channel path to be received at the location (base communication unit comprising means for encoding video data into a telephone signal and providing the decoded geographic position information to the mobile unit operator via visual images while the mobile operator communicates with the operator, col. 6, lines 30-39), providing a radio transponder and GPS receiver and microprocessor module at the location to receive and process location data in response to receipt of the radio signal (see Fig. 1, col. 3, lines 43-57), to receive and process location data from a GPS satellite constellation (see col. 1, lines 15-28), for the portable cellular telephone and to activate the transponder to transmit the processed location data over the data channel to the control center by associating the transmitted location data with the user voice call request at the control center (see col. 3, lines 15-28), and sending location services information from the control center to the user (see col. 7, line 61 to col. 8, line 14). Pace meets all limitations of except the feature and means for user verification.

Girerd discloses a system for providing location service information from a server to a client, which includes for example requiring that a user provide the user's name and password so that the user can be charged for the service (see col. 5, lines

Art Unit: 2682

51-56). Girerd alternatively discloses that service can be provided as part of a user's cellular telephone or pager account, whereby a user may also be provided with a means for identifying a remote sensor of interest using an identification code such as the remote sensor's cellular telephone number, or other unique identifying number (see col. 5, lines 56-63).

It would therefore have been obvious to one of ordinary skill in the art to incorporate the unique identification feature for user verification of Girerd into the system of Pace in order to provide desired location information and services to desired users for the benefit of ensuring appropriate billing for the use of the location services if required.

Regarding claim 2, Pace further shows sending the location services information from the control center over the cellular radio-voice channel path to the user (see col. 9, lines 20-45).

Regarding claims 3, 7, 10 and 14, Pace fails to specifically teach wherein when the vehicle user, when remote from the vehicle, access a web portal interfacing with the channels to determine the location of the vehicle and that the data path is selected from the group consisting of satellite communications links, two-way paging networks and through web portals via the Internet.

Girerd further teaches the capability of a user to access and display Web documents over the Internet (see col. 3, 28-60) and that the cellular phone may include a modem or other appropriate for the method of data transmission used (see col. 4, lines 38-40).

It would therefore have been obvious to one of ordinary skill to provide for Internet capability cellular telephone as taught by Girerd to be used in the location service provision system of Pace in order to take advantage of the wide array of resources and services available over web portals via the Internet.

Regarding claims 4 and 11 Pace further shows wherein the voice channel path is selected from the group consisting of SMR, VHF, UHF, GSM, satellite and cellular telephone (see col. 4, lines 38-46).

Regarding claims 5-6 and 12-13, Pace further teaches that the benefits of tracking technology in providing base unit operators, for example trucking companies, rental car fleet operators and sales managers with the ability to track the geographic location of their vehicles and that receivers of GPS signals configured inside mobile telephones can receive and transmit GPS signals received from satellite-based navigation systems to base unit operators for provide accurate geo-reference positions, as well as textual description of events, observations and findings associated with a location (see col. 1, lines 11-587), suggesting the capability of fleet managers using the GPS modules in the vehicles to monitor or track the location of the vehicles without interrupting the vehicle driver or user, while Girerd further teaches the capability of obtaining information over the Internet (see col. 3, lines 28-60, col. 4, lines 38-40), Novik discloses a system and method for tracking and graphically displaying the positions of vehicles in a fleet in which the vehicles are equipped with a GPS receiver for communicating GPS information

Regarding claim 9, Pace further shows sending the location services information from the control center over the cellular radio-voice channel path to the user (see col. 9, lines 20-45).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Novik (6,339,745) discloses a system for fleet tracking using GPS.

Fan et al. (5,959,577) discloses a method for processing position and travel information through a data network.

Johnson (5,986,543) teaches a system for monitoring a vehicle using a two-way communication with a central monitoring station.

Sheffer (5,515,419) teaches a tracking system for tracking a movable object carrying a cellular phone.

Hollenberg (6,091,956) discloses a wireless system for providing situation information to mobile users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703 305-6739. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703 308-6296 for After Final communications.

Application/Control Number: 09/662,278

Page 9

Art Unit: 2682

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 306-0377.

CA  
March 24, 2003

*Ch Appiah*  
**CHARLES APPIAH**  
**PATENT EXAMINER** (PRIMARY)